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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,311	12/28/2001	Hitoshi Nakai	723-1239	4773

7590 10/15/2003
NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Rd.
Arlington, VA 22201-4714

EXAMINER

MARKS, CHRISTINA M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 10/15/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,311

Applicant(s)

NAKAI, HITOSHI

Examiner

C. Marks

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

----- The drawings are objected to because the work SWITCH is misspelled in FIG. 19. A -----
proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 3 is objected to because of the following informalities: the step should be step (c) instead of step (d) as claim 3 depends only on claims 1 and there is no intermittent step of (c).

Claim 4 is objected to because of the following informalities: the step should be step (c) instead of step (e) as claim 4 depends only on claims 1 and there are no intermittent steps of (c) or (d).

Claim 6 is objected to because of the following informalities: the step should be step (c) instead of step (f) as claim 6 depends only on claims 1 and there are no intermittent steps of (c)-(e).

Claims 7 is objected to for using the steps (g), (h), and (i) for the reasons detailed above in that it only depends from claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

----- The following is a quotation of the second paragraph of 35 U.S.C. 112: -----

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-14, the claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Further regarding claims 2 and 3, the usage of the slash in the phrase permits/prohibits renders the claims indefinite in that it would not be clear to one of ordinary skill in the art which of the conditions, or if both, need to be satisfied.

Regarding claims 8 and those dependent therefrom, the word "means" is preceded in the claim by the word(s) "first transmission" and "second transmission" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

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Regarding claim 10, the claim is narrative so much that one of ordinary skill in the art would not understand how the limitations would match up to the parent claim. It is indefinite in that some of the limitations are contradictory towards that which is claimed by the parent. For instance, step (c) in the parent says the game server requests a log in operation while claim 10 states that it is determined whether or not the operation is carried and then requesting a transmit when it is carried out. This is indefinite in that the parent has already carried out such a request; therefore, one of ordinary skill in the art would not understand how the limitations relate to each other.

Regarding claims 13 and those dependent therefrom, the word "means" is preceded in the claim by the word(s) "player information receiving", "first guiding", "requesting" and "second guiding" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Further regarding claim 13, one of ordinary skill in the art would not understand how a user could be guided to a log in operation based on a request while not logging-in. It seems contradictory to a skilled artisan to guide someone to log in who is supposed to be not logging-in.

For examination purposes, the claims will be evaluated as best understood by one of ordinary skill in the art.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-12 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-12 recite a game program to be executed by a computer that is not tangibly stored; therefore, its operation is not statutory as is it not tangibly embodied within the computer structure and does not have a post-production result.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 and 11-14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over ICQ (Accessed from the Internet Archive for ICQ pages dating 15 August 2000).

ICQ is a chat program that has a method of allowing a user to request another user enters a game with the user (ICQ, Game Request). The system has a server that provides forums for games to a first computer apparatus (ICQ, Game Request) of a user who has logged in and is one of a plurality of players previously registered. The player on the ICQ network can receive information from the server representing a second player who does not have to be logged in (ICQ User Menu, User's Details). The person need only be on your contact list, not logged in. ICQ enables users to send messages to those who are not online (ICQ, User Menu) in a number of ways. The user can send the message over ICQ which will be viewed when the user logs in, over an email to another user which can be viewed the next time the user logs in (ICQ E-mail Integration), by using ICQmail which allows the player to send any information to a players offline ICQ mail account wherein the player can get the message without signing back onto the service (ICQmail) or use Phone "Follow Me" and actually attempt to place a call to the user (ICQ, The User Menu). The system of ICQ does not explicitly disclose the content of the infinite amount of possible messages that could be sent over ICQmail, only that its purpose is to allow contact with users not online. Therefore because of the feature allowing users to request others to play games, it would have been obvious to one of ordinary skill in the art as well as to a user who desires a particular partner in a game to use the email function to immediately send a log-in request to a user not currently logged-in in order to complete a game request. Thus, by selecting the player for the game request and using the email contact function to ask the player to

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play, the player would be able to initiate a gaming session with another player who is not currently signed on. One of ordinary skill in the art would understand that the motivation for using the email for such a feature would lie in the fact that the player could then contact any partner he or she desires regardless of whether that player is currently signed on or not. With the information and function available from ICQ and the ability to serve as a gateway to a game apparatus, it would be highly desirable to use the functions available for the maximum level of communication and interaction between on and offline users, thus enhancing their enjoyment garnished from the system. Further, because the ICQ system enables the use of gaming, the computer housing user programs would be considered to an ordinary artisan, as a game apparatus within the scope of the art and the server connecting two of these game apparatus would thus be a game server.

Regarding claims 2-4, ICQmail and ICQ itself have a number of features built in to protect the privacy of the user. If the user does not wished to be bothered an Ignore List can be set up that allows the user to ignore all users if they desire (ICQ, ICQ Security and Privacy). Though not explicitly disclosed in the ICQmail available offline, it is disclosed that the user can choose not to accept and EmailExpress messages and thus one of ordinary skill in the art would find it obvious in order to further protect the user from being contacted to block all messages relating to the parameters set up by the user in their preference settings. Thus, matching the sender of ICQmail to an ICQ subscriber, known to those in the art, the system would ignore any such messages originating from a logged-in person and thus as the user desired, such person be ignored. One of ordinary skill in the art would be motivated to incorporate this ignore feature into the ICQmail relating to ICQ users in order to further protect the privacy desired by the user.

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Thus, the login operation would not be transmitted to the second user. By extending the flags associated with ignored ICQ users to the ICQ mail account, as is already done on the express mail account, the wishes of the user regarding privacy could further be honored and thus increasing the satisfaction of the user by not allowing the delivery of undesired messages which is an important goal in all communication applications. Regarding sending back the messages,

-----the-ICQmail-incorporates-a-function-that-allows-mail-to-be answered-with-a-standard-message. It-----
would be obvious to one of ordinary skill in the art that even though the user desires no messages and the messages are not transmitted to the user because of the desire to not actually receive messages, a return could be set to be sent to the user once the ICQmail detects an attempt to deliver in order to inform them the player is not accepting communication. This is disclosed in ICQmail as desirable when you want to inform other that you are not present. This would be a standard communication courtesy in order to let the first player know that the second player will not be participating in a game and thus the first player will not be waiting around. Such a communication would be obvious to a skilled artisan motivated in order to provide the first user with a confirmation of denial thus decreasing wasted time by the first user who would then seek a new playing partner which was the goal of the contact in the first place and thus the first user would receive a greater enjoyment in the game by not waiting around for a user who is not even accepting communication. Regarding a second message when the login operation is denied by the second apparatus, one of ordinary skill in the art understand based on the disclosure of the connection within the ICQ system, that the user could send back any message they desire to the ICQ user and it would be received by the first apparatus.

Regarding claim 5, based on the manner by which the second player is contacted, the first player will thus be identified in the login request as the request would initiate from the first players account directly to the second players email where it would be known that the first players identification information would be shown.

Regarding claim 6, ICQ has the players register personal information in their user profiles and other players can access this information when other players are selecting or searching for others (ICQ, User Menu and ICQ, Find People).

Regarding claim 7, ICQ serves as a game server between any number of participants that wish to participate in a game and there are a number of types of games that can be played as long as the players have them also installed in their gaming apparatus. Thus, such games as Quake and other type of online RPGs can be played as long as they are resident on the gaming apparatus (ICQ, How to Use Game Request). The characters are stored in memory (in order to allow future access) and skilled artisans understand in such role-playing games that each player is associated with a character that is visually different from other characters in order to distinguish the characters in their roles. Character signals for player not logged on can be present or merely represent the absence of a character. Thus, such incorporation into the disclosure of ICQ and its gaming would be obvious to the types of games supported by the game server setup.

Regarding claim 8, the content of the limitations has been disclosed above and further it would be known based on the disclosure that different transmission means would be used for the two transmissions. The same exact means would not be used when sending mail as when a player is getting information regarding another.

Regarding claim 9, the system of ICQ receives from the server player information about any player on the users list, as disclosed above, regardless of whether the player is actually logged in (ICQ, Guided Tour- Product Features). It has been discussed above how the system can be used to select a player by presenting information (ICQ, Find People) and proceeds to transmit a log in request to that player based upon a mail request to do so by the first player.

~~Regarding claim 11, as discussed above, the login request would axiomatically include~~
identification of the request source. This identification would be detected from the login request as the request is sent by email and thus the information would be included and thus detectable. Since the user constructs the message as defined above and as further defined the object would be to invite the player, a guide message would be included in that it would ask the player to log on thus guiding them to do so.

Regarding claim 12, as discussed above, regarding sending back the messages, the ICQmail incorporates a function that allows mail to be answered with a standard message. It would be obvious to one of ordinary skill in the art that even though the user desires no messages and the messages are not transmitted to the user because of the desire to not actually receive messages, a return could be set to be sent to the user once the ICQmail detects an attempt to deliver in order to inform them the player is not accepting communication. This is disclosed in ICQmail as desirable when you want to inform other that you are not present. This would be a standard communication courtesy in order to let the first player know that the second player will not be participating in a game and thus the first player will not be waiting around. Such a communication would be obvious to a skilled artisan motivated in order to provide the first user with a confirmation of denial thus decreasing wasted time by the first user who would then seek

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a new playing partner which was the goal of the contact in the first place and thus the first user would receive a greater enjoyment in the game by not waiting around for a user who is not even accepting communication.

Regarding claim 13, it has been discussed above that the computer game apparatus allows a player to receive information regarding players who are not logged in and has a feature to guide the player in selecting specific players based on player information. The system also allows a request to be sent from the first player to a second player regarding a log in and the second player could then log into the system if desired. The previously registered player axiomatically has a link to the login that will serve as a second guiding means.

Regarding claim 14, a skilled artisan understands that a program is used to run the features and functionality of the ICQ system disclosed above. Therefore, storing such a program on a medium would be obvious to a skilled artisan as the program must axiomatically be stored on the hard drive medium in order to be read.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over ICQ in view of McSheffrey et al. (US Patent No. 6,264,562).

ICQ teaches of using email to instantiate login requests but does not teach that the player performs a move on another character and when the move is carried out, then the system transmits the login request.

McSheffrey et al. teach this concept in an email games wherein the first player uses displayed characters and makes a move designated for a second player (Column 2). The system then sends a login request to the second player when the move has been carried out. This, like

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ICQ, is done in the form of email. The email contains the move data as well as a request to open a game program, thus logging into the game, and perform a subsequent move.

It would have been obvious to one of ordinary skill in the art to employ the concept of McSheffrey et al. into the system of ICQ. One of ordinary skill in the art would be motivated to make this incorporation to let the game have forward progress even if the players are not able to coordinate their schedules thus increasing the satisfaction between two parties who desire to play but can not get their schedules to meet. By prompting this login at this time, it would also serve as a means to connect the two parties, as disclosed by ICQ if both are available thus increasing the enjoyment of users who can get in touch as well as those who cannot.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The History of Electronic Mail: Details the known process in which users can communicate with each other without being signed into a service.

Offline Messages: Details a system that would let offline messages be sent to users and give the user the option to get the message or refuse messages.

AOL Instant Messenger: Allows a functionality that would allow the player to email another player who is offline to establish a communication.

US Patent No. 6,168,524: Details character appearance and control in an RPG environment wherein a character represents a player.

US Patent No. 6,406,371: Data regarding each tem is transmitted to other teams from terminal to terminal that generate a login ID and transfer the login ID as well as the game data.

US Patent No. 6,416,414: Plurality of participants transmit to at least one play station for taking part in a game by means of messaging in mobile devices.

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US Patent No. 6,389,127: Telephone line status notification that allows users to seek other users through requests.

US Patent No. 6,446,118: Method for notifying a user not connected to their computer that information has been sent to them.

US Patent No. 6,587,691: Arrangement and method to allow communication between mobile users.

US Patent No. 5,379,340: Communication system that allows messaging between users that requires acknowledgement from the receiver by acknowledgement receipt.


US Patent No. 6,449,344: Communication system that allows users to communicate with other users through a network and has the ability to seek others.


US Patent No. 6,512,930: System that notifies users in a mobile system of the status of other users in the system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.


cmm
October 9, 2003


Teresa Walberg
Supervisory Patent Examiner
Group 3700